

REMARKS

This Response is to the Office Communication mailed on 14 November 2006 (Paper No. 20061111), which was issued in response to Applicant's Amendment filed on 20 April 2006, and is a supplemental response to the Office action mailed on 20 October 2005 (Paper No. 20051011). In the Communication, the Examiner states that the previously filed Reply Brief was not fully responsive to the prior Office Action because of the following omissions or matters:

Listing of the Claims

Claims 38 through 81 are pending in the application, and are set forth in the following listing. Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Status of Pending Claims

Claims 38 through 81 are pending in the application. Claims 1 through 37 were previously canceled without prejudice or disclaimer of their subject matter.

Amendment of the Claims

Claims 40, 45, 55, 63, 64 and 75 are amended.

Rejection of Claims 44 and 64 Under 35 U.S.C. §112

Claims 44 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses both of these rejections for the following reasons.

In support of this rejection, the Examiner argues in essence that Claims 44 and 64 are rejected under the second paragraph of 35 U.S.C. §112 for lack of antecedent basis. The Examiner states that there is no antecedent basis in claim 44 for "the destination" in line 7. Careful examination of claim 44 establishes that there is no "line 7"; moreover, the term "the

destination” which appears in line 2, has express antecedent basis in line 8 of parent claim 38.

The Examiner continues by arguing that there is no antecedent basis in claim 64 for “the document” in line 14.” Applicant notes that the preamble of claim 64 reads, “A system for printing *a document*”

Given the foregoing demonstration of the fallacy of the underlying basis urged by the Examiner in support of this rejection, it may not be maintained and must be withdrawn.

Paper No. 20051011 questions whether claim 64 is indefinite in that there is no antecedent basis for “the document” in line 14. Applicant notes that antecedent basis for *document* is found in line 1 of the preamble of claim 64.

Claim Rejections - 35 U.S.C. § 102

- A. Claims 45-53 and 64-71 are rejected under 35 U.S.C. §102(e) as being anticipated by Gross *et al.*, U.S. Patent No. 6,918,082.**

Applicant respectfully traverses the rejection of claims 45-53 and 64-71 under 35 U.S.C. §102(e) as being anticipated by Gross *et al.*, U.S. Patent No. 6,918,082. for the following reasons:

In support of the rejection, the Examiner states that:

Applicant claims an Internet printing apparatus comprising a printing agency server, a memory having stored thereon a customer's choice of attributes for a print job, an editor connected to said first memory, and an output device connected to said first memory. Gross *et al.* disclose an electronic proofing system comprising a document server, a database, and an output device (see Figs. 1 and 2; and col. 8, lines 64-68). Note that this rejection does not give weight to the remainder of the claim limitations because they are intended use for the claimed apparatus. Because the Gross *et al.* apparatus is capable of performing the intended use, Gross *et al.* anticipates the claimed subject matter.

Applicant's claim 45 defines, *inter alia*, apparatus, comprising:

“a printing agency, comprising a server disseminating a home page that, in response to an inquiry by a customer over the World Wide Web, provides instructions explaining how a customer can request an estimation of cost of a print job and enables a customer to select and to modify attributes of said print job, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job of a first draft received from the customer; said printing agency comprising a memory storing a customer's choice of attributes for said print job and, subsequent to delivery of said estimation to the customer, storing a first draft of said print job composed by the customer independently of said printing agency as a work that is textually distinct from said attributes and that is received from the customer via the World Wide Web; said printing agency comprising an editor connected to said memory to edit said first draft of said print job to create a first revision of said first draft to enable said customer to receive said first revision via the World Wide Web, and to receive from the customer via the World Wide Web, a second draft prepared by the customer in dependence upon said first revision, and to generate a finalized version in dependence upon said second draft; said memory being connected to said editor and storing said finalized version of said print job; and an output device connected to said memory via a network printing to download said finalized version onto a recording media at a location that is geographically compatible with the customer's choice”;

while Applicant's claim 64 defines a system comprising:

“a printing agency comprising a server accessible via the Internet, said server providing a port accommodating transmission of information between said print agency and computers of users accessing the Internet; said printing agency comprising an editor editing a manuscript composed by a corresponding one of the users independently of said printing agency with at least one of text, image and pictorial components and submitted by the corresponding one of the users to said printing agency to produce the document, said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in response to reception of a revision of said first

draft from the corresponding one of the users; and a first plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network printing.”

In contradistinction, Gross ‘083 describes “a system which simultaneously displays multiple versions of a portable format document over a computer network,”¹ but which lacks a teaching or suggestion of such salutary features of Applicant’s rejected claims as, by way of example, “a server ... providing instructions ... an estimation of cost ... to modify attributes of said print job”² or “an editor connected to said memory ... to receive from the customer ... a second draft prepared by the customer ...”³, or “an editor editing a manuscript composed by a corresponding one of the users independently of said printing agency ... [and]... disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users”⁴ In any interpretation of Gross ‘083, both quotes of cost and the cost of printing and manufacturing are nowhere mentioned; in other words, the needs of a “graphic designer” such as “Roger”⁵ discussed in Gross ‘083 are incompletely addressed by Gross ‘083. *Nicholas V. Perricone, M.D. v. Medicis Pharmaceutical Corporation*, ___ F.3d ____, #05-1022, -1023 (Fed. Cir. 20 December 2005)citing *Hewlett-Packard Co., v. Mustek Sys., Inc.*, 340 F.3d 1314, 1324 n.6 (Fed. Cir. 2003) “The anticipation analysis asks solely whether the prior art reference discloses and enables the claimed invention, and not how the prior art characterizes that disclosure or whether alternatives are also disclosed.” Here, the foregoing demonstration establishes that

¹ Gross ‘082, column 2, lines 63 and 64, claim 1, lines 49 and 50, claim 10, (col. 10) lines 22 and 23, and claim 17, (col. 11) lines 2 and 3.

² Claim 45.

³ Claim 45.

⁴ Claim 64.

⁵ Gross ‘083, column 7, lines 49 and 50.

Gross '083 fails to anticipate the entirety of claim s 45 through 53 and 64 through 71;⁶ withdrawal of this rejection is therefore required.⁷

B. Claims 45-53 and 64-71 are rejected under 35 U.S.C. §102(e) as being anticipated by Vogt *et al.*, U.S. Patent No. 6,611,349.

Claims 45 through 53 and 64 through 71 are rejected under 35 U.S.C. §102(e) as being anticipated by Vogt *et al.*, U.S. Patent No. 6,611,349. Applicant respectfully traverses this rejection for the following reasons:

In support of the rejection, the Examiner states that:

Applicant claims a printing apparatus as noted above. Vogt *et al.* disclose printing a publishing system comprising a document server, a database, and an output device (see Fig. 5). Note that this rejection does not give weight to the remainder of the claim limitations because they are an intended use for the claimed apparatus. Because the Gross *et al.* apparatus is capable of performing the intended use, Gross *et al.* anticipates the claimed subject matter.

Note that if claims 45-53 and 64-71 were interpreted to require the functional limitations recited, these claims would have been an obvious modification of the references discussed below.

This conclusory statement is unsupported by the evidence in the record of Applicant's prosecution history before the Examiner.

First, Applicant is confused by the reference by the Examining staff to "Gross *et al.*" in its discussion of this rejection because the rejection is framed as anticipation under 35 U.S.C. §102(e) by Vogt *et al.*, U.S. Patent No. 6,611,349. The express reliance by the

⁶ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single prior art reference*." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁷ §2131, *Manual of Patent Examining Procedure*, 8th Ed., Rev. 5 (Aug. 2006).

Examining staff upon a second reference is convincing evidence of a lack of anticipation. Withdrawal of this rejection is therefore required.⁸

Second, the Examiner's reference to "functional limitations" is not understood. Nothing in either the statute or the Code of Federal Regulations distinguishes between "functional limitations" and other portions of the text of the claims; this distinction is artificial and is contrary to U.S. practice.

Third, the Examiner argues that "if claims 45-53 and 64-71 were interpreted to require the functional limitations recited, these claims would have been an obvious modification of the references discussed below"; this assertion is unsupported by the applied art, namely Vogt '349, and contrary to the Examiner's suggestion, no "modification" is either taught or suggested by Vogt '349.

Fourth, Vogt '349 fails to make a *prima facie* demonstration of anticipation. By way of example, although Vogt '349 contemplates a class of metadata "stored in the asset tables ... such as cost", Vogt '349 "includes rules limiting ... access to tables indicating the price of products" ⁹ Consequently, and as is recognized by the Examiner, the fact that "Vogt et al. do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer" rendered Vogt '349 unable to anticipate Applicant's combination;¹⁰ accordingly, there is no anticipation and under current Office practice, this rejection may not be sustained.¹¹

Claim Rejections - 35 U.S.C. § 103(a)

C. Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 are rejected under 35 U.S.C.

⁸ §2131, *Manual of Patent Examining Procedure*, 8th Ed., Rev. 5 (Aug. 2006).

⁹ Vogt '349, column 16, lines 17-19 and 36 and 37.

¹⁰ "The *identical* invention must be shown in as complete detail as is contained in the ... *claim*." *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

¹¹ §2131, *Manual of Patent Examining Procedure*, 8th Ed., Rev. 5 (Aug. 2006).

**103(a) as being unpatentable over Gross *et al.* '082 in view of Sevcik *et al.*,
U.S. Patent No. 6,330,542.**

Claims 38, 39, 43, 45 through 62, 69 through 71, 75, 76 and 81 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 modified according to Sevcik *et al.*, U.S. Patent No. 6,330,542. Applicant respectfully traverses this rejection for the following reasons.

In support of the rejection, the Examiner states that:

Applicant claims a method a method for printing a document comprising a offering a printing service, receiving, by a merchant from a customer, a request for quote (RFQ) for a print job, said merchant issuing an estimate for said print job, receiving from the customer a first draft of the print job, said merchant editing said first draft and providing said edited first draft to the customer, generating a revised draft based on said edited first draft, and outputting said revised draft to a remote output device.

Gross *et al.* disclose a method for providing a printing service comprising a customer creating a draft document (col. 3, lines 54-55, 59-60), a proofer at a printing merchant receiving said draft (col. 3, lines 55-57), said proofer reviewing the draft and commenting on said draft (col. 4, lines 6-11), sending said draft and comments to the customer and said customer revising said draft and returning said revised draft to said printing service (col. 4, lines 25-42), and sending the revised draft to a printing agency for printing (col. 4, lines 42-47).

Gross *et al.* do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer. However, Sevcik *et al.* teach [*sic.*, “teaches”] a method for issuing a cost estimate for a printing job comprising displaying to a customer a catalog of print services (Fig. 1A, char. 32), receiving from said customer a selection of print services including item specific options (Fig. 1A, char. 63), and issuing to said customer a cost estimate based on said customer selection (Fig. 1A). At the time of Applicant's invention, it was well known that a quoting process could be used to price services. This would have been very desirable for a printing service such as Gross *et al.*,’s since a the variation between customer print jobs prevents a standard price structure. Thus, it would have been obvious to one skilled

in the art provide Gross et al.'s service with Sevcik et al.'s quoting process in order to provide a price for custom print jobs.

Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method since the method is designed to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, this distinction does not make Applicant's method patentable as it would have been obvious to make this change. At the time of Applicant's invention, it was customary for a customer (i.e. contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience. Thus, it would have been obvious to allow Gross et al.'s customer to select the remote output device as provided in the claims.

Applicant's method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction. The Examiner submits at the time of Applicant's invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

Applicant's method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility. The Examiner submits it would have been obvious to have Gross et al.'s method include these corrections since Gross et al. is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.

First, the rationale given by the Examiner in support of this rejection ignores the express teachings of the Examiner's proposed combinations. Specifically, the Examiner's assertion that "it would have been obvious to one skilled in the art provide Gross et al.'s service with Sevcik et al.'s quoting process in order to provide a price for custom print jobs" because the primary reference depends upon the flawless interaction of "*collaborative production and review* of documents"¹² while the secondary reference fails to complement

¹² Gross, *et al.* '082, column 2, line 48.

the primary reference, and instead teaches that:

“[f]or every job, there is a series of steps, which occur from when the quote is generated, to when the job is closed. Each of these steps is tracked within the system.”¹³

Moreover, the primary reference makes no provision for generation of an estimate prior to the user contracting with the graphics contractor, and instead in the Examiner’s proposed combination expressly allocates the “responsibility ... to find a printer”¹⁴ to the graphics contractor, while the secondary reference is dedicated to providing “a more efficient system that not only addresses the needs of buyers, but also the needs of the printing provider ...[by providing] the buyer with quotations that have been generated from multiple printer providers”¹⁵ The selective picking and choosing of particular elements for the primary reference and seeking to substitute other elements from the secondary reference is a classic instance of an impermissible hindsight reconstruction of the art in the light provided solely by Applicant’s claims. The mere fact that references **can** be modified or combined does not render the combination obvious unless the prior art also suggests the desirability of the combination.”¹⁶ Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”¹⁷ Accordingly, this rejection fails to demonstrate either motivation or other basis for the Examiner’s proposed combination.

Second, absent from the Examiner’s proposed combination is any basis for modifying

¹³ Sevick ‘542, column 15, lines 45 and 55.

¹⁴ Gross ‘082, column 8, line 60-61.

¹⁵ Sevick ‘542, column 2, lines 38 through 53.

¹⁶ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990).

¹⁷ *In re Mills*, 916 F.2d 682, 16 USPQ2d a 1432 (Fed.Cir. 1990). See also, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

the *collaborative production and review of documents*¹⁸ process taught by the primary reference, in order to endow a multiplicity of individual users to separately and simultaneously select and edit attributes of their individual products. Selection in the Examiner's proposed combination, of an output device to manufacture a document is limited to the printing contractor's ability to "find a printer" ¹⁹ In short, the process of the Examiner's proposed combination expressly allocates the "responsibility ... to find a printer"²⁰ upon the graphics contractor; consequently, the Examiner's proposed combination would impermissibly prevent the primary reference from operating in its intended mode.

Third, the intensive editing process disclosed by the primary reference is unable to accommodate the icon representative product price menu of the secondary reference. Where precisely is a representation of price to be incorporated into the primary reference except at the completion of publishing? Recognizing that the secondary reference is directed to "aggregating the volume" of multiple products²¹ in order to attain cost savings, while the primary reference is directed to editing of unique, distinctive products which evolve throughout the process disclosed by the primary reference, precisely which version of the product in the primary reference serves as the basis for a cost estimation? Recognition that the proposed combination incorporating the cost estimation feature of the secondary reference expressly teaches away from the repetitive iterations which require multiple quotes,²² reinforces the total absence of any motivation for modifying the primary reference

¹⁸ Gross '082, column 2, line 48.

¹⁹ Gross '082, column 8, line 60-63. "it is now the responsibility of ABC Graphics & Design to find a printer, preferably in St. Louis, to print the CD-ROM covers and deliver them to the XYZ distribution center."

²⁰ Gross '082, column 8, line 60-61.

²¹ Sevcik '542, column 3, lines 7-35.

²² See, for instance, Sevcik '542, column 5, lines 20 through 67 and column 6, lines 1 and 2.

in the manner urged by the Examiner. Accordingly, this rejection is improper and may not be maintained.

Fourth, in support of this rejection, the Examining staff improperly asserts that:

“Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method since the method is designed to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, this distinction does not make Applicant's method patentable as it would have been obvious to make this change. At the time of Applicant's invention, it was customary for a customer (*i.e.* contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience. Thus, it would have been obvious to allow Gross et al.'s customer to select the remote output device as provided in the claims.”

This is contrary to the express mandate of 35 U.S.C. §103(a) which requires the Office to make a determination based upon whether “the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* sought to be patented *and* the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made”²³ Truncation of the “*subject matter as a whole*” is unlawful; by statute the Examining staff must therefore give patentable weight to Applicant’s “allowing the customer to select the output device”

Fifth, the naked assertion by the Examining staff that at the time of Applicant’s invention “it was customary for a customer (*i.e.* contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience” does not excuse the lack of evidence in the record demonstrating the expressed conclusion of the Examining staff that therefore “it would have been obvious to allow Gross et al.'s customer to select the remote output device as provided in the

²³ 35 U.S.C. §103(a)

claims.”²⁴

Sixth, patentability of claims 38, 39, 43, 45 through 62, 69 through 71, 75, 76 and 81 do not turn upon the definition of Applicant’s endowment of a user with an ability to participate in selection of the output device designated to manufacture a printed product. As earlier noted, the subject matter of each claim must be considered “*as a whole*.”

D. Rejection of claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.*, U.S. Patent No. 6,611,349 in view of Sevcik *et al.*, U.S. Patent No. 6,330,542.

Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.*, U.S. Patent No. 6,611,349 in view of Sevcik *et al.*, U.S. Patent No. 6,330,542. Applicant respectfully traverses this rejection for the following reasons.

In the previous Office action, the Examiner stated the Vogt *et al.* ‘349 discloses,

“a method of providing a publishing service comprising a customer creating a document having images and text (Fig. 6, char. 610-640; col. 2, lines 3940, 43-45; col. 11, lines 35-37), forwarding said document to a proofing device over a communication network (Fig. 6, char. 645; col. 11, lines 37-44), said proofing device making revisions to said document and making said revised document available to said customer (Fig. 8B, Char. 850), said customer approving said revised document (Fig. 8B, Char. 850), and providing said revised document to a printing agency (Fig. 6, Char. 655).”

²⁴ In point of fact, other art of record such as the Cowan paper, Cowan (“*Traditional and On-Demand Printers Say Distributed Printing Saves Time-, Money, and Is a Driver of Industry Consolidation*”, Printing News (May 1999) vol. 142, No. 18, p. 20), which is a survey of practices among printers for *remote printing*, teaches that is the custom in the art for the printing contractor to select a facility for *remote printing* from among those facilities owned by the printing contractor. Absent from exemplars of the art such as Cowan is any suggestion of a relation between the geographic location of the *remote printing* facilities and that of the user.

The Examiner admitted however that Vogt *et al.* '349 does not expressly disclose, receiving a RFQ and issuing a cost estimate to a customer. The Examiner then stated that it would have been obvious to include this feature in view of Sevcik *et al.* '542.

The Examiner further stated that,

“[t]his rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method which is to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, it would have been obvious to include this step as discussed above, Applicant’s method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction.”

The Examiner then concluded that at the time of Applicant’s invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

First, whether the prior art could be modified to endow a customer with an ability to select an output device is immaterial to the question of obviousness. Under 35 U.S.C. §103(a), the teachings of the Examiner’s proposed combination must be considered “at the time the invention was made.”²⁵ At that time, as is evidenced given this admission that the Examiner’s proposed combination is unable to give “the customer [an option to] selects the output device” as defined by Applicant’s claim 55, the Examiner’s proposed combination fails to make a *prima facie* showing of obviousness.

Second, this rejection is improperly premised upon the fact that the Examiner “does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24).” Under current Office practice, the *Graham*²⁶ factual inquiries are guided by the requirement that “(A) The claimed invention must be considered as a

²⁵ The requirement “at the time the invention was made” is to avoid impermissible hindsight. See *MPEP* §2145.

²⁶ *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

whole.”²⁷ The admission that the Examining staff has failed to “give patentable weight” to a feature of Applicant’s claim is improper under both current Office practice²⁸ and to the requirements laid out by *Graham*.²⁹ The Examining staff has therefore, failed to follow Office policy, and has failed to make “the consideration and determination of obviousness under 35 U.S.C. §103.”³⁰ Accordingly, this rejection is improper and may not be maintained.

Third, the Examiner stated that,

“Applicant’s method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility”, and then concluded that “it would have been obvious to have Vogt et al.’s method include these corrections since Vogt et al. is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.”

The record before the Office does not support this conclusion. The Examiner’s proposed combination including Vogt *et al.* ‘349, has a printing and publishing system that uses a *pre-press system* which generates a printing plate-ready file from data provided remotely in real time using a communication network”³¹ with a “central service facility 105” that transmits to “an end user facility 300” equipped with “digital color proofer 300” (which is a 4-color

²⁷ §2141, *Manual of Patent Examining Procedure*, 8th Ed., Rev. 5 (Aug. 2006).

²⁸ “Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. §103.” §2141, *MPEP* (Aug. 2006).

²⁹ “[T]he four factual inquiries enunciated” by *Graham* are: “(A) Determining the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations.” *MPEP* §2141 (Aug. 2006).

³⁰ §2141, *Manual of Patent Examining Procedure*, 8th Ed., Rev. 5 (Aug. 2006).

³¹ Vogt *et al.* ‘349, col. 2, lines 50-53.

machine) and a “black and while laser printer 340” that “provide printed copies.”³² In the parlance of the Examiner’s proposed combination, “*proofing* involves producing a proof, or sample, of what the printed product will look like. The proof is sent ... to the end user for review and approval.”³³

The Examiner’s proposed combination however, requires,

“forwarding said document to a *proofing device* over a communication network (Fig. 6, char. 645; col. 11, lines 37-44), said *proofing device making revisions to said document* and making said revised document available to said customer (Fig. 8B, Char. 850).”³⁴

Utterly unexplained in Paper No. 20051011 is any explanation of how in the Examiner’s proposed combination, “digital color proofer 300” (which is a 4-color machine) and a “black and while laser printer 340” that “provide printed copies”³⁵ are able to function by “*making revisions to said document*”?³⁶ In point of fact, neither “digital color proofer 300” nor “black and white laser printer 340” are able to make *revisions to said document*.³⁷ Applicant submits that this proposed combination fails to make a *prima facie* showing of obviousness and is simply a hindsight reconstruction of the art in light of the map provided by Applicant’s claims.

Fourth, it may be seen that Paper No. 20051011 is incomplete under the standards of 37 CFR §1.104(a) and (b). Applicant respectfully requests that the Examiner complete Paper No. 20051011 by providing to Applicant in non-final Office correspondence, an explanation

³² Vogt *et al.* ‘349, col. 7, lines 51-56

³³ Vogt *et al.* ‘349, col. 1, lines 31-33.

³⁴ Examiner’s Comments, Paper No. 20051011.

³⁵ Vogt *et al.* ‘349, col. 7, lines 51-56

³⁶ Examiner’s Comments, Paper No. 20051011.

³⁷ Examiner’s Comments, Paper No. 20051011.

of how “digital color proofer 300” nor “black and white laser printer 340” are able to make *revisions to said document* as is stated by Paper No. 20051011. Absent explanation, withdrawal of this rejection is respectfully requested.

- E. Rejection of claims 40-42, 44, 63, 72-74, and 77-80 under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.*, U.S. Patent No. 6,918,082 in view of Sevcik *et al.* ‘542 and further in view of Cowan (“*Traditional and On-Demand Printers Say Distributed Printing Saves Time-, Money, and Is a Driver of Industry Consolidation*”, *Printing News* (May 1999) vol. 142, No. 18, p. 20).**

Claims 40 through 42, 44, 63, 72 through 74, and 77 through 80 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.*, U.S. Patent No. 6,918,082 in view of Sevcik *et al.* ‘542 and further in view of a paper authored by Cowan entitled “*Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation*”, published in *Printing News* (May 1999) Vol. 142, No. 18, p. 20). Applicant respectfully traverses this rejection for the following reasons.

In the previous Office action, the Examiner stated that, the invention of these claims further limited the invention discussed in claims 38, 39, 43, 45 through 62, 69 through 71, 75, 76 and 81 by providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. Despite this assertion however, the Examiner admitted that, the combination of Gross *et al.* ‘082 and Sevcik *et al.* ‘542 does not teach selecting a remotely located output device. The Examiner attempted to gloss over this deficiency in the proposed combination by arguing that “it would have been obvious to one of ordinary skill in the art” to modify Gross *et al.* ‘082 and Sevcik *et al.* ‘542 to include this feature.

In addition, the Examiner stated that,

Cowan makes it clear that at the time of Applicant’s invention, print service providers were allowing customers to select a convenient location for print job pick-up and/or distribution (p.

1), and that Cowan teaches that allowing customers to select a print location reduces printing charges, saves time and provides extra service.³⁸

The Examiner's assertion is not true. A through reading of page 1 of Cowan uses the noun "customer" in but two instances:

- In the first instance, Cowan is referring to WAM!Net, an Internet service provider.
- In the second instance, Cowan is describing in terms of one printing contractor's "presence in nine U.S. regional markets ... [that] lets ... [that graphics contractor serve] the kind of customer that wants to do design and pre-press work in one city, but distribute print production among the country"

Contrary to the Examiner's assertion, the proposed combination says nothing about "Cowan teaches that allowing customers to select a print location." In point of fact, in the Examiner's proposed combination, it remains "the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver"³⁹ In contradistinction, Applicant's inventions focus upon the ability of the "output device" of the printing entity, whether that entity is the printing agency itself or a subcontractor, to conform to the attributes selected by the user for the resulting product, and to make those selections of the attributes via the Internet. This combination, and the concomitant advantages of use and enhanced availability of selection tendered by Applicant's embodiments to the user, are not available with the Examiner's proposed combination. The rationale given by the Examiner in support of this rejection improperly fails comply with the express mandate of 35 U.S.C. §103(a) to consider

³⁸ This is a distortion of the actual teachings of these references. The Examiner's proposed combination uses the term *customer* but twice, and never in conjunction with the verb *select*.

³⁹ Gross, *et al.*, '082, column 8, lines 60-63.

the differences between the subject matter sought [with that subject matter being taken as a whole] to be patented and the prior art. If the Examining staff would consider the subject matter which Applicant seeks to patent *as a whole*, the Applicant submits that the Examining staff would find that *subject matter* provides advantages to both the user and the printing agency which are unavailable (*e.g.*, the fact that the tendering of an already catalogued of possible selections of attributes, when considered alone, greatly facilitates the convenience provided to the user) through the proposed combination. In short, the Examiner's proposed combination adds nothing to the primary reference, and fails under 35 U.S.C. §103(a) to render obvious Applicant's claims.

The Examiner then concluded that it would have been obvious to one of ordinary skill in the art to modify Gross *et al.* '082 and Sevcik *et al.* '542 to allow a customer to select a printer (*i.e.* output device) location in order to make print services cheaper.

A thorough reading of the Examiner's proposed combination reveals that the combination teaches nothing "allowing customers to select a print location."⁴⁰

F. Rejection of claims 40-42, 44, 63, 72-74, and 77-80 under 35 U.S.C. §103(a) as being unpatentable over Herbert, U.S. Patent No. 6,707,931 in view of Sevcik *et al.* '542 and further in view of Cowan.

Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,707,931 B2) in view of Sevcik, *et al.* (US 6,330,542) and further in view of "Cowan" (Cowan, L. "*Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation*" Printing News (May 1999) vol. 142, no. 18, p. 20). Applicant respectfully traverses this rejection for the following reasons.

⁴⁰ In actuality, the Examiner's proposed combination is a survey of practices by printers for use of *remote printing*, and nowhere explains how the use of the printer's remote printers might be modified to endow the user to either select from among those printers or to enable the user to make a selection among users on the basis of geographic proximity to the user.

First, the effective data of Herbert '931 is the 26th of April 2002, more than eighteen (18) months after Applicant's Japanese priority date on the 13th of October 2000. Consequently, neither the Examiner's proposed combination nor Herbert '931 is available as *prior art*.⁴¹ This rejection may not therefore, be maintained. Its withdrawal is required.

Second, in support of this rejection the Examiner argued that,

“The invention is interpreted as noted above. Herbert and Sevcik, *et al.* do not expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. However, for the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify Herbert and Sevcik, *et al.* to include Cowan's teaching of a remotely located output device.”

The Examiner admitted that neither Herbert '931 nor Sevcik *et al.* '542 expressly taught that the output device is positioned at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. The Examiner concluded however, that it would have been obvious to one of ordinary skill in the art to modify Herbert '931 and Sevcik *et al.* '542 to include what the Examining staff asserts is Cowan's teaching of a remotely located output device.⁴² No evidence of record supports this conclusion. Contrary to the Examiner's assertion, the proposed combination says itself fails to confirm that “Cowan teaches that allowing customers to select a print location.” In point of fact, in the Examiner's proposed combination, it remains “the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver”⁴³ In contradistinction,

⁴¹ The Examiner's attention is respectfully invited to note that Herbert is not identified as a joint inventor in Provisional Application No. 60/195.688 filed on the 7th of April 2000.

⁴² In point of fact, the Cowan paper is a survey of practices among printers for *remote printing*. Absent from Cowan is any suggestion of a relation between the geographic location of the *remote printing* facilities and that of the user.

⁴³ Gross, *et al.*, '082, column 8, lines 60-63.

Applicant's inventions focus upon the ability of the "output device" of the printing entity, whether that entity is the printing agency itself or a subcontractor, to conform to the attributes selected by the user for the resulting product, and to make those selections of the attributes via the Internet. This combination, and the concomitant advantages of use and enhanced availability of selection tendered by Applicant's embodiments to the user, are not available with the Examiner's proposed combination. The rationale given by the Examiner in support of this rejection improperly fails comply with the express mandate of 35 U.S.C. §103(a) to consider *the differences between the subject matter sought* [with that *subject matter* being taken as a whole] *to be patented and the prior art*. If the Examining staff would consider the subject matter which Applicant seeks to patent *as a whole*, the Applicant submits that the Examining staff would find that *subject matter* provides advantages to both the user and the printing agency which are unavailable (*e.g.*, the fact that the tendering of an already catalogued of possible selections of attributes, when considered alone, greatly facilitates the convenience provided to the user) through the proposed combination. In short, the Examiner's proposed combination adds nothing to the primary reference, and fails under 35 U.S.C. §103(a) to render obvious Applicant's claims.

Absent factual basis therefore, this rejection is untenable and may not be sustained. Its withdrawal is required.

G. Claims 40-42, 44, 63, 72-74, and 77-80 were rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.* '349 in view of Sevcik *et al.* '542 and further in view of Cowan.

In the previous Office action, the Examiner admitted that neither the Examiner's proposed combination of Vogt *et al.* '349 nor Sevcik *et al.* '542, nor Vogt *et al.* '349 or Sevcik *et al.* '542 taken individually, expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device.

The Examiner stated however that it would have been obvious to one of ordinary skill

in the art to modify the teachings of Vogt *et al.* '349 and Sevcik *et al.* '542 to include Cowan's teaching of a remotely located output device. The Examiner's proposed combination fails to address the "subject matter" of the rejected claims "as a whole" as is required by 35 U.S.C. §103(a);⁴⁴ nothing in the Examiner's proposed combination teaches or suggests how the Examiner's proposed combination might be modified to meet Applicant's ability to endow the user with either an opportunity to make a selection of attributes resulting in a designation of a printer on the basis of the relative location of the printer to the user. Instead, the Examiner's proposed combination dwells upon the selection of the printer by the printing contractor, on the basis of freight charges and company ownership of off-site printers. Selection by the user is not taught by the Examiner's proposed combination. Consequently, the Examiner's proposed combination lacks the advantageous enablement of the user to select a printer on a basis personal to the user, as opposed to the printing contractor. Given these distinctions and the noted advantages flowing therefrom, claims 40 through 42, 44, 63, 72 through 74, and 77 through 80 are patentably distinguishable and allowable over the Examiner's proposed combination of art.

Moreover, and contrary to the Examiner's assertion, the proposed combination says nothing about "Cowan teaches that allowing customers to select a print location." In point of fact, in the Examiner's proposed combination, it remains "the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver"⁴⁵ In contradistinction, Applicant's inventions focus upon the ability of the "output device" of the printing entity, whether that entity is the printing agency itself or a subcontractor, to conform to the attributes selected by the user for the resulting product, and to make those selections of the attributes via the Internet. This combination, and the concomitant advantages of use and

⁴⁴ 35 U.S.C. §103(a) requires the Examining staff to consider whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made"

⁴⁵ Gross, *et al.*, '082, column 8, lines 60-63.

enhanced availability of selection tendered by Applicant's embodiments to the user, are not available with the Examiner's proposed combination. The rationale given by the Examiner in support of this rejection improperly fails comply with the express mandate of 35 U.S.C. §103(a) to consider *the differences between the subject matter sought* [with that *subject matter* being taken as a whole] *to be patented and the prior art*. If the Examining staff would consider the subject matter which Applicant seeks to patent *as a whole*, the Applicant submits that the Examining staff would find that *subject matter* provides advantages to both the user and the printing agency which are unavailable (*e.g.*, the fact that the tendering of an already catalogued of possible selections of attributes, when considered alone, greatly facilitates the convenience provided to the user) through the proposed combination. In short, the Examiner's proposed combination adds nothing to the primary reference, and fails under 35 U.S.C. §103(a) to render obvious Applicant's claims.

H. Claims 40-42, 44, 63, 72-74, and 77-80 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 in view of Sevcik *et al.* '542 and further in view of Adamske *et al.*, U.S. Patent No. 6,615,234.

Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. §103(a) as being rendered obvious, and unpatentable, over the Examiner's proposed combination of Gross *et al.* '082 modified by Sevcik *et al.* '542 and Adamske *et al.*, U.S. Patent No. 6,615,234. In the previous Office action, the Examiner admitted that the combination of Gross *et al.* '082 and Sevcik *et al.* '542 does not teach selecting a remotely located output device.

In Paper No. 20051011 the Examiner stated that Adamske *et al.* '234 teaches a system and method for network-based document delivery wherein a user is allowed to select the destination for picking up the hard copy of a desired document (col. 4, lines 9-39), and then concluded that at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Gross *et al.* '082 and Sevcik *et al.* '542 to include Adamske *et al.* 234's teaching of permitting the customer to select the delivery location for the

document. The Examiner further stated that this combination would increase the value of Gross *et al.*'s document service by increasing customer convenience.

This rationale, in point of fact, can not be supported by the express teachings of the Examiner's proposed combination. Specifically, and in contradistinction to the rejected claims, the Examiner's proposed combination depends upon a "document delivery system"⁴⁶ which "allows a user to have an electronic document delivered in hard copy form to any number of geographically remote locations in a **number of hours or less**"⁴⁷ by the expedient of either "using **overnight delivery service 18** ... [to] retrieve the hard copy document 50 from printer 40, package the hard copy document and route it via plane and courier service using its existing network",⁴⁸ or by sending "the electronic document ... over the network 12 to a customer pick-up location to be printed on printer 40 and held for the recipient at the customer pick-up location."⁴⁹ Neither the Examiner's proposed combination, nor the rationale advanced by the Examining staff in an endeavor to explain that proposed combination, makes a *prima facie* showing of obviousness under 35 U.S.C. §103(a), because the Examining staff's efforts to modify Gross *et al.* '082 and Sevcik *et al.* '542 to include Adamske *et al.*'s teaching of permitting the customer to select the delivery location for the document, ignores the deficiencies in the Gross *et al.* '082 and Sevcik *et al.* '542 components of that proposed combination earlier identified herein.

First, the Examiner's assertion that "it would have been obvious to one skilled in the art provide Gross *et al.*'s service with Sevcik *et al.*'s quoting process in order to provide a price for custom print jobs" because the primary reference depends upon the flawless

⁴⁶ Adamske *et al.* U.S. 6.615.234, col. 3, line 17.

⁴⁷ Adamske *et al.* U.S. 6.615.234, col. 3, lines 23-26.

⁴⁸ Adamske *et al.* U.S. 6.615.234, col. 4, lines 21-24.

⁴⁹ Adamske *et al.* U.S. 6.615.234, col. 4, lines 26-28.

interaction of “*collaborative production and review of documents*”⁵⁰ while the secondary reference fails to complement the primary reference, and instead teaches that:

“[f]or every job, there is a series of steps, which occur from when the quote is generated, to when the job is closed. Each of these steps is tracked within the system.”⁵¹

Moreover, the primary reference makes no provision for generation of an estimate prior to the user contracting with the graphics contractor, and instead in the Examiner’s proposed combination expressly allocates the “responsibility ... to find a printer”⁵² to the graphics contractor, while the secondary reference is dedicated to providing “a more efficient system that not only addresses the needs of buyers, but also the needs of the printing provider ... [by providing] the buyer with quotations that have been generated from multiple printer providers”⁵³ The selective picking and choosing of particular elements for the primary reference and seeking to substitute other elements from the secondary reference is a classic instance of an impermissible hindsight reconstruction of the art in the light provided solely by Applicant’s claims. The mere fact that references **can** be modified or combined does not render the combination obvious unless the prior art also suggests the desirability of the combination.”⁵⁴ Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”⁵⁵ Resort to *Adamske et al.* 234’s teachings do not remedy this deficiency. Accordingly, this rejection fails to demonstration either motivation or other basis for the Examiner’s

⁵⁰ Gross, *et al.* ‘082, column 2, line 48.

⁵¹ Seveck ‘542, column 15, lines 45 and 55.

⁵² Gross ‘082, column 8, line 60-61.

⁵³ Seveck ‘542, column 2, lines 38 through 53.

⁵⁴ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990).

⁵⁵ *In re Mills*, 916 F.2d 682, 16 USPQ2d a 1432 (Fed.Cir. 1990). See also, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

proposed combination.

Second, absent from the Examiner's proposed combination is any basis for modifying the *collaborative production and review of documents*⁵⁶ process taught by the primary reference, in order to endow a multiplicity of individual users to separately and simultaneously select and edit attributes of their individual products. Selection in the Examiner's proposed combination, of an output device to manufacture a document is limited to the printing contractor's ability to "find a printer" ⁵⁷ In short, the process of the Examiner's proposed combination expressly allocates the "responsibility ... to find a printer" ⁵⁸ upon the graphics contractor; consequently, the Examiner's proposed combination would impermissibly prevent the primary reference from operating in its intended mode.

Third, the intensive editing process disclosed by the primary reference is unable to accommodate the icon representative product price menu of the secondary reference. Where precisely is a representation of price to be incorporated into the primary reference except at the completion of publishing? Recognizing that the secondary reference is directed to "aggregating the volume" of multiple products⁵⁹ in order to attain cost savings, while the primary reference is directed to editing of unique, distinctive products which evolve throughout the process disclosed by the primary reference, precisely which version of the product in the primary reference serves as the basis for a cost estimation? Recognition that the proposed combination incorporating the cost estimation feature of the secondary reference expressly teaches away from the repetitive iterations which require multiple

⁵⁶ Gross '082, column 2, line 48.

⁵⁷ Gross '082, column 8, line 60-63. "it is now the responsibility of ABC Graphics & Design to find a printer, preferably in St. Louis, to print the CD-ROM covers and deliver them to the XYZ distribution center."

⁵⁸ Gross '082, column 8, line 60-61.

⁵⁹ Sevcik '542, column 3, lines 7-35.

quotes,⁶⁰ reinforces the total absence of any motivation for modifying the primary reference in the manner urged by the Examiner. Accordingly, this rejection is improper and may not be maintained.

Fourth, in support of this rejection, the Examining staff improperly asserts that:

“Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method since the method is designed to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, this distinction does not make Applicant's method patentable as it would have been obvious to make this change. At the time of Applicant's invention, it was customary for a customer (*i.e.* contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience. Thus, it would have been obvious to allow Gross et al.'s customer to select the remote output device as provided in the claims.”

This is contrary to the express mandate of 35 U.S.C. §103(a) which requires the Office to make a determination based upon whether “the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* sought to be patented *and* the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made”⁶¹ Truncation of the “*subject matter as a whole*” is unlawful; by statute the Examining staff must therefore give patentable weight to Applicant’s “allowing the customer to select the output device”

Fifth, the naked assertion by the Examining staff that at the time of Applicant’s invention “it was customary for a customer (*i.e.* contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for

⁶⁰ See, for instance, Sevcik ‘542, column 5, lines 20 through 67 and column 6, lines 1 and 2.

⁶¹ 35 U.S.C. §103(a)

example, past experience” does not excuse the lack of evidence in the record demonstrating the expressed conclusion of the Examining staff that therefore “it would have been obvious to allow Gross et al.’s customer to select the remote output device as provided in the claims.”⁶²

Sixth, patentability of claims 38, 39, 43, 45 through 62, 69 through 71, 75, 76 and 81 do not turn upon the definition of Applicant’s endowment of a user with an ability to participate in selection of the output device designated to manufacture a printed product. As earlier noted, the subject matter of each claim must be considered “*as a whole*.”

I. Claims 40-42, 44, 63, 72-74, and 77-80 were rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.* ‘349 in view of Sevcik *et al.* ‘542 and further in view of Adamske *et al.* ‘234.

In the previous Office action, the Examiner admitted that neither Vogt ‘349 nor Sevcik *et al.* ‘542 expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. The Examiner stated however that it would have been obvious to one of ordinary skill in the art to modify the teachings of Vogt’ 349 and Sevcik *et al.* ‘542 to include *et al.*’s teaching of a remotely located output device as taught by Adamske ‘234. Applicant respectfully traverses this rejection for the following reasons.

The Examiner asserted however, that in this proposed combination, Adamske *et al.* ‘234 teaches a system for network-based document delivery wherein a user is allowed to

⁶² In point of fact, other art of record such as the Cowan paper, Cowan (“*Traditional and On-Demand Printers Say Distributed Printing Saves Time-, Money, and Is a Driver of Industry Consolidation*”, Printing News (May 1999) vol. 142, No. 18, p. 20), which is a survey of practices among printers for *remote printing*, teaches that is the custom in the art for the printing contractor to select a facility for *remote printing* from among those facilities owned by the printing contractor. Absent from exemplars of the art such as Cowan is any suggestion of a relation between the geographic location of the *remote printing* facilities and that of the user.

select the destination for picking up hard copies of a desired document (col. 4, lines 9-39).

The Examiner then concluded that,

“at the time of Applicants’ invention, it would have been obvious to one of ordinary skill in the art to modify Vogt *et al.* ‘349 to include Adamske *et al.*’s teaching of a plurality of output devices located at one or more locations separate from the printing agency, and that this combination would increase the value of Vogt *et al.*’s document service by increasing customer convenience.”

This rationale does not make a *prima facie* showing of obviousness under 35 U.S.C. §103(a), because the Examiner’s proposed combination depends upon a “document delivery system”⁶³ which “allows a user to have an electronic document delivered in hard copy form to any number of geographically remote locations in a **number of hours or less**”⁶⁴ by the expedient of either “using **overnight delivery service 18** ... [to] retrieve the hard copy document 50 from printer 40, package the hard copy document and route it via plane and courier service using its existing network”,⁶⁵ or by sending “the electronic document ... over the network 12 to a customer pick-up location to be printed on printer 40 and held for the recipient at the customer pick-up location.”⁶⁶ In contradistinction, the rejected claims contemplate, *inter alia*,

“a printing agency ... an editor editing a manuscript composed by a corresponding one of the users independently of said printing agency with ... components and submitted by the corresponding one of the users to said printing agency to produce the document, said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in

⁶³ Adamske *et al.* U.S. 6.615.234, col. 3, line 17.

⁶⁴ Adamske *et al.* U.S. 6.615.234, col. 3, lines 23-26.

⁶⁵ Adamske *et al.* U.S. 6.615.234, col. 4, lines 21-24

⁶⁶ Adamske *et al.* U.S. 6.615.234, col. 4, lines 26-28.

response to reception of a revision of said first draft from the corresponding one of the users; and

a first plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network”

The Examiner’s proposed combination of the art however, fails to make a *prima facie* demonstration of obviousness because the primary reference, Vogt ‘349 contemplates a class of metadata “stored in the asset tables ... such as cost”, and Vogt ‘349 “includes rules limiting ... access to tables indicating the price of products ...”⁶⁷, while both Vogt ‘349 and Sevcik ‘542 are devoid of any aspect of Applicant’s delivery of either an estimate or quote of the cost for performing a job based upon the attributes selected by the user. Consequently, and as is recognized by the Examiner, the fact that “Vogt *et al.* do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer” renders the proposed combination of the Examiner staff based upon modification of Vogt ‘349 and Sevcik ‘542 to including the printing features of Adamske ‘234 unable to anticipate Applicant’s combination,⁶⁸ accordingly, there is neither a *prima facie* showing of obviousness and no demonstration of obviousness in fact; under current Office practice, this rejection may not be sustained.⁶⁹ Withdrawal of t his rejection is therefore respectfully

⁶⁷ Vogt ‘349, column 16, lines 17-19 and 36 and 37.

⁶⁸ “The *identical* invention must be shown in as complete detail as is contained in the ... *claim*.” *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁶⁹ *MPEP* §706.02(j) requires that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the evidence of record must demonstrate “three basic criteria **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.” This demonstration

urged.

J. Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 in view of Cowan.

Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 in view of Cowan. Applicant respectfully traverses this rejection for the following reasons.

In the previous Office action, the Examiner stated that:

the present invention claims that a system for printing a document comprises (A) a printing agency server, (B) a printing agency editor capable of (i) editing a manuscript from a user to produce a draft document, (ii) submitting said draft document, and (iii) receiving the customer's revisions to said draft document, and (C) a plurality of output devices located at one or more locations that are separate from said printing agency, wherein said output device is a printer.

The Examiner also stated that,

"Gross *et al.* '082 discloses a printing apparatus comprising a central computer capable of receiving a document from a user (Fig. 1, char. 60; col. 3, lines 52-57), a proofer computer system in communication with said central computer, wherein said proofer computer is configured to proof user documents (Fig. 1, char. 52; col. 3, line 66 - col. 4, line 5)."

The Examiner admitted however that,

"Gross *et al.* '082 does not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency."

The Examiner stated however that,

is mandatory, and may not be evaded by the Examining staff., 8th Ed., Rev. 5 (Aug. 2006).

“it would have been obvious to one of ordinary skill in the art to modify Gross *et al.* ‘082 to include this feature. The Examiner further stated that Cowan makes it clear that at the time of Applicant’s invention, print service providers were allowing customers to select a printing location for convenient pick-up or distribution. (p. 1), and that Cowan teaches that allowing customers to select a print location reduces printing charges, saves time and provides extra service.”

The Examiner then concluded that,

“it would have been obvious to one of ordinary skill In the art to modify Gross *et al.* ‘082 to allow a customer to select a printer location (i.e. output device) in order to offer printing services at a lower cost.”

First, the rationale given by the Examiner in support of this rejection ignores the express teachings of the Examiner’s proposed combinations. Specifically, the Examiner’s assertion that “Cowan makes it clear that at the time of Applicant’s invention, print service providers were allowing customers to select a convenient location for print job pick-up and/or distribution (p. 1), and that Cowan teaches that allowing customers to select a print location reduces printing charges, saves time and provides extra service” is grossly misplaced.⁷⁰ In short, the Examiner’s proposed combination adds nothing to the primary reference, and fails to render obvious Applicant’s claims” because the primary reference

⁷⁰ The Examiner’s assertion is not true. A through reading of page 1 of Cowan uses the noun “customer” in but two instances. In the first instance, Cowan is referring to WAM!Net, an Internet service provider. In the second instance, Cowan is describing in terms of one printing contractor’s “presence in nine U.S. regional markets ... [that] lets ... [that graphics contractor serve] the kind of customer that wants to do design and pre-press work in one city, but distribute print production among the country” Contrary to the Examiner’s assertion, the proposed combination says nothing about “Cowan teaches that **allowing customers to select** a print location.” In point of fact, in the Examiner’s proposed combination, it remains “the responsibility of ... [the graphics contractor] **to find a printer** ... to print ... and deliver ... ” as taught by Gross, *et al.*, ‘082, column 8, lines 60-63.

depends upon the flawless interaction of “*collaborative production and review of documents*”⁷¹ and expressly places selection of a printer squarely upon the graphics contractor.

Second, neither the primary reference nor the Examiner’s proposed combination make provision for generation of an estimate prior to the user contracting with the graphics contractor. Instead the Examiner’s proposed combination expressly allocates the “responsibility ... to find a printer”⁷² to the graphics contractor; the secondary reference is dedicated to (a) the practice of printers who have remote printing facilities, to digitally transmit print order to one of their remote print facilities, and (b) the traditional local printers such as American Litho that “sends them elsewhere”⁷³ when a customer requests *remote printing*.⁷⁴ The selective picking and choosing of particular elements for the primary reference and seeking to substitute other elements from the secondary reference is a classic instance of an impermissible hindsight reconstruction of the art in the light provided solely by Applicant’s claims. The mere fact that references **can** be modified or combined does not render the combination obvious unless the prior art also suggests the desirability of the combination.”⁷⁵ Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do

⁷¹ Gross, *et al.* ‘082, column 2, line 48.

⁷² Gross ‘082, column 8, line 60-61.

⁷³ Cowan, page 2, 6th full paragraph.

⁷⁴ “Despite this kind of testimony, heard frequently from local players, it is difficult to say whether local printers get little call for remote printing because they are ill equipped to provide it, or vice versa. Perhaps a little of both.” Cowan, page 2, 7th full paragraph. Note that even with Cowan’s multitudinous contractual arrangements between customers and their local printers, it remains the responsibility of the local printer to designate or to select the printing subcontractor.

⁷⁵ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990).

so.”⁷⁶ Accordingly, this rejection fails to demonstrate either motivation or other basis for the Examiner’s proposed combination; concomitantly, the Examiner’s proposed combination fails to make a *prima facie* showing of obviousness of Applicant’s claims 64 through 68. And, even more to the point, the proposed combination of the Examining staff both ignores and utterly fails to address the fact that in the proposed combination of the Examining staff, no provision is made to endow the customer, as opposed to the customer’s graphic vendor, to arbitrarily and freely select a printer (*e.g.*, a printing subcontractor). In point of fact, in the Examiner’s proposed combination, it remains:

“the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver ... ”

as is taught by Gross, *et al.*, ‘082, column 8, lines 60-63. In other words, not only does the Examiner’s proposed combination fail to make a *prima facie* showing of obviousness under 35 U.S.C. §103(a), but the proposed combination has failed to give weight to the *subject matter sought to be patented ... as a whole* as is expressly required by 35 U.S.C. §103(a). Consequently, the rejection is improper under 35 U.S.C. §103(a), and is incomplete. Withdrawal of this rejection and allowance of claims 64 through 68 is therefore, respectfully urged.

Third, and contrary to the rationale argued by the Examining staff, the proposed combination says nothing that supports the assertion made by the Examining staff that “Cowan teaches that allowing customers to select a print location.” In point of fact, in the Examiner’s proposed combination, it remains “the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver ... ”⁷⁷ In contradistinction, Applicant’s inventions focus upon the ability of the “output device” of the printing entity, whether that entity is the printing agency itself or a subcontractor, to conform to the attributes selected

⁷⁶ *In re Mills*, 916 F.2d 682, 16 USPQ2d 1432 (Fed.Cir. 1990). See also, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

⁷⁷ Gross, *et al.*, ‘082, column 8, lines 60-63.

by the user for the resulting product, and to make those selections of the attributes via the Internet. This combination, and the concomitant advantages of use and enhanced availability of selection tendered by Applicant's embodiments to the user, are not available with the Examiner's proposed combination. The rationale given by the Examiner in support of this rejection improperly fails comply with the express mandate of 35 U.S.C. §103(a) to consider *the differences between the subject matter sought* [with that *subject matter* being taken as a whole] *to be patented and the prior art*. If the Examining staff would consider the subject matter which Applicant seeks to patent *as a whole*, the Applicant submits that the Examining staff would find that *subject matter* provides advantages to both the user and the printing agency which are unavailable (*e.g.*, the fact that the tendering of an already catalogued of possible selections of attributes, when considered alone, greatly facilitates the convenience provided to the user) through the proposed combination. In short, the Examiner's proposed combination adds nothing to the primary reference, and fails under 35 U.S.C. §103(a) to render obvious Applicant's claims.

K. Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 in view of Adamske '234.

Claims 64 through 68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gross *et al.* '082 in view of Adamske '234. Applicant traverses this rejection for the following reasons.

In the previous Office action, the Examiner stated that Gross *et al.* '082 does not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency.

The Examiner stated however that Adamske *et al.* '234 teaches a system for network-based document delivery wherein a user is allowed to select the destination for *picking up hard copies* of a desired document (col. 4, lines 9-39). The Examiner then concluded that at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Gross *et al.* '082 to include Adamske *et al.*'s teaching of

a plurality of output devices located at one or more locations separate from the printing agency, and that this combination would increase the value of Gross *et al.*'s document service by increasing customer convenience.

First, the rationale given by the Examiner in support of this rejection ignores the express teachings of the Examiner's proposed combinations. Specifically, the Examiner's assertion that "it would have been obvious to one skilled in the art to provide Gross *et al.*'s service with Adamske *et al.* '234's teaching of a system for network-based document delivery wherein a user is allowed to select the destination for *picking up hard copies* of a desired document (col. 4, lines 9-39) is both misguided in its understanding of the terminology used by the art, and in its application of that art to the rejected claims.⁷⁸ With the Examiner's proposed combination, "document delivery server system 20 further connects, via network 12, to remote printer spooler 30 connected to printer 40 **at the delivery destination.**"⁷⁹ The primary reference depends upon the flawless interaction of "*collaborative production and review of documents*"⁸⁰ while the secondary reference fails to complement the primary reference, and instead teaches that:

"[t]he electronic document is then printed on a printer 40 connected to the print spooler server 30. The electronic document is then printed on a printer 40 connected to the print spooler server 30. The hard copy document can then be delivered to the recipient."⁸¹

⁷⁸ The Examiner is respectfully invited to consider the he has confused *delivery* of printed (*i.e.*, manufactured) copies in the Examiner's proposed combination (taught, for example, by Adamske *et al.* '234) with the Applicant's participation of the selection of the *manufacturing* of those copies (*i.e.*, the *printing* of those copies) prior to the *delivery* of those copies. If the Cowan paper is to be believed, this distinction is not insubstantial.

⁷⁹ Adamske *et al.* '234, column 4, lines 58-60.

⁸⁰ Gross, *et al.* '082, column 2, line 48.

⁸¹ Adamske *et al.* '234, column 4, lines 5-7.

Moreover, the primary reference makes no provision for generation of an estimate prior to the user contracting with the graphics contractor, and instead in the Examiner's proposed combination expressly allocates the "responsibility ... to find a printer"⁸² to the graphics contractor, while the secondary reference is dedicated to providing "a more efficient system that not only addresses the needs of buyers, but also the needs of the printing provider ... [by providing] the buyer with quotations that have been generated from multiple printer providers"⁸³ The selective picking and choosing of particular elements for the primary reference and seeking to substitute other elements from the secondary reference is a classic instance of an impermissible hindsight reconstruction of the art in the light provided solely by Applicant's claims. The mere fact that references **can** be modified or combined does not render the combination obvious unless the prior art also suggests the desirability of the combination."⁸⁴ Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."⁸⁵ Accordingly, this rejection fails to demonstrate either motivation or other basis for the Examiner's proposed combination.

L. Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.* '349 in view of the Cowan paper.

Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.* '349 in view of the Cowan paper. Applicant respectfully traverses this rejection for the following reasons.

⁸² Gross '082, column 8, line 60-61.

⁸³ Sevvick '542, column 2, lines 38 through 53.

⁸⁴ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990).

⁸⁵ *In re Mills*, 916 F.2d 682, 16 USPQ2d a 1432 (Fed.Cir. 1990). See also, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the previous Office action, the Examiner stated that,

“Vogt *et al.* ‘349 discloses a system architecture for remote printing and publishing- services comprising a central service facility server capable of receiving and storing a document from a user (Fig. 1, char. 130, Fig. 6, lines 27-41) and a proofing device for editing user documents (Fig. 4, char. 410; and col. 8, lines 26-46).”

The Examiner admitted however that Vogt *et al.* ‘349 does not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency.

The Examiner stated however, Adamske *et al.* ‘234 teaches a system for network-based document delivery wherein a user is allowed to select the destination for picking up hard copies of a desired document (col. 4, lines 9-39).

The Examiner then concluded that at the time of Applicants’ invention,

“it would have been obvious to one of ordinary skill in the art to modify Vogt *et al.* ‘349 to include Adamske *et al.*’s teaching of a plurality of output devices located at one or more locations separate from the printing agency, and that this combination would increase the value of Vogt *et al.*’s document service by increasing customer convenience.”

Applicant respectfully traverses this rejection because, and contrary to the Examiner’s assertion, the proposed combination says nothing about “Cowan teaches that allowing customers to select a print location.” In point of fact, in the Examiner’s proposed combination, it remains “the responsibility of ... [the graphics contractor] *to find a printer* ... to print ... and deliver”⁸⁶ In contradistinction, Applicant’s inventions focus upon the ability of the “output device” of the printing entity, whether that entity is the printing agency itself or a subcontractor, to conform to the attributes selected by the user for the resulting product, and to make those selections of the attributes via the Internet, as is available with Applicant’s system defined by claims 64 through 68. This combination, and the concomitant

⁸⁶ Gross, *et al.*, ‘082, column 8, lines 60-63.

advantages of use and enhanced availability of selection tendered by Applicant's embodiments to the user, are not available with the Examiner's proposed combination.

The rationale given by the Examiner in support of this rejection improperly fails comply with the express mandate of 35 U.S.C. §103(a) to consider *the differences between the subject matter sought* [with that *subject matter* being taken *as a whole*] *to be patented and the prior art*. If the Examining staff would consider the subject matter which Applicant seeks to patent *as a whole*, the Applicant submits that the Examining staff would find that *subject matter* provides advantages to both the user and the printing agency which are unavailable (*e.g.*, the fact that the tendering of an already catalogued of possible selections of attributes, when considered alone, greatly facilitates the convenience provided to the user) through the proposed combination. In short, the Examiner's proposed combination adds nothing to the primary reference, and fails under 35 U.S.C. §103(a) to render obvious Applicant's claims.

M. Claims 64-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Vogt *et al.* '349 in view of Adamske 234.

Claims 64 through 68 are rejected under 35 U.S.C. §103(a) as being unpatentable over the examiner's proposed combination of Vogt *et al.* '349 modified by Adamske 234. Applicant respectfully traverses this rejection for the following reasons.

In the previous Office action, the Examiner stated that,

"Vogt *et al.* '349 discloses a system architecture for remote printing and publishing services comprising a central service facility server capable of receiving and storing a document from a user (Fig. 1, char. 130; Fig. 6, lines 27-41) and a proofing device for editing user documents (Fig. 4, char. 410; and col. 8, lines 26-46)."

The Examiner admitted however that Vogt *et al.* '349 does not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency.

The Examiner asserted however, that Adamske *et al.* '234 teaches a system for

network-based document delivery wherein a user is allowed to select the destination for picking up hard copies of a desired document (col. 4, lines 9-39).

The Examiner then concluded that,

“at the time of Applicants’ invention, it would have been obvious to one of ordinary skill in the art to modify *Vogt et al.* ‘349 to include *Adamske et al.*’s teaching of a plurality of output devices located at one or more locations separate from the printing agency, and that this combination would increase the value of *Vogt et al.*’s document service by increasing customer convenience.”

This rationale does not make a *prima facie* showing of obviousness under 35 U.S.C. §103(a), because the Examiner’s proposed combination depends upon a “document delivery system”⁸⁷ which “allows a user to have an electronic document delivered in hard copy form to any number of geographically remote locations in a **number of hours or less**”⁸⁸ by the expedient of either “using **overnight delivery service 18** ... [to] retrieve the hard copy document 50 from printer 40, package the hard copy document and route it via plane and courier service using its existing network”,⁸⁹ or by sending “the electronic document ... over the network 12 to a customer pick-up location to be printed on printer 40 and held for the recipient at the customer pick-up location.”⁹⁰ In contradistinction, the rejected claims contemplate, *inter alia*,

“a printing agency comprising a server accessible via the Internet, said server providing a port accommodating transmission of information between said print agency and computers of users accessing the Internet;
said printing agency comprising an editor editing a

⁸⁷ *Adamske et al.* U.S. 6.615.234, col. 3, line 17.

⁸⁸ *Adamske et al.* U.S. 6.615.234, col. 3, lines 23-26.

⁸⁹ *Adamske et al.* U.S. 6.615.234, col. 4, lines 21-24

⁹⁰ *Adamske et al.* U.S. 6.615.234, col. 4, lines 26-28.

manuscript composed by a corresponding one of the users independently of said printing agency with at least one of text, image and pictural components and submitted by the corresponding one of the users to said printing agency to produce the document, said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users; and

a first plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network”

The Examiner’s proposed combination of the art however, fails to make a *prima facie* demonstration of obviousness because the primary reference, Vogt ‘349 contemplates a class of metadata “stored in the asset tables ... such as cost”, and Vogt ‘349 “includes rules limiting ... access to tables indicating the price of products ...”⁹¹, while the secondary reference is devoid of any aspect of Applicant’s delivery of either an estimate or quote of the cost for performing a job based upon the attributes selected by the user. Consequently, and as is recognized by the Examiner, the fact that “Vogt *et al.* do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer” renders the proposed combination of the Examiner staff based upon modification of Vogt ‘349 to including the printing features of Adamske ‘234 unable to anticipate Applicant’s combination.⁹²

Moreover, the Examiner’s inference “it would have been obvious to one skilled in the art to” provide Vogt ‘349 service with Adamske *et al.* ‘234’s teaching of a system for network-based document delivery wherein a user is allowed to select the destination for *picking up hard copies* of a desired document (col. 4, lines 9-39) is both misguided in its

⁹¹ Vogt ‘349, column 16, lines 17-19 and 36 and 37.

⁹² “The *identical* invention must be shown in as complete detail as is contained in the ... *claim*.” *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

understanding of the terminology used by the art, and in its application of that art to the rejected claims.⁹³

Accordingly, there is neither a *prima facie* showing of obviousness and no demonstration of obviousness in fact; under current Office practice, this rejection may not be sustained.⁹⁴ Withdrawal of this rejection is therefore respectfully urged.

SUMMARY

Unlike the art cited by Paper No. 20051011, pending claims 38 through 81 enable a user seeking to practice Applicant's inventions to participate in each stage of the process, from product specification, cost estimation, editing and pre-press, final approval and manufacturing. In the various proposed combinations of art poised by the Examiner, the user is forced to surrender control over one, or most, of the various steps, to either the graphics contractor or to the printing contractor. Consequently, flexibility is lost and, more significantly, control of the ultimate costs, are shifted by the Examiner's proposed

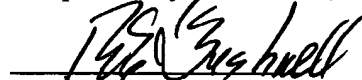
⁹³ The Examiner is respectfully invited to consider that he has confused *delivery* of printed (*i.e.*, manufactured) copies in the Examiner's proposed combination (taught, for example, by Adamske *et al.* '234) with the Applicant's participation in the selection of the *manufacturing* of those copies (*i.e.*, the *printing* of those copies) prior to the *delivery* of those copies. If the Cowan paper is to be believed, this distinction is not insubstantial.

⁹⁴ MPEP §706.02(j) requires that in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the evidence of record must demonstrate "three basic criteria **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." This demonstration is mandatory, and may not be evaded by the Examining staff., 8th Ed., Rev. 5 (Aug. 2006).

combinations, beyond the user. In contradistinction, a user practicing Applicant's inventions not only participates in the entire process, but is singularly endowed with a flexibility, by way of example, through the user's selections, to make trade-offs during the process such as, by way of example, between his selections during formulation of the product's specifications, or by way of an alternative example, between his selection of printers, or, by way of a second alternative example, by deleting, altering varying content during editing; this flexibility concomitantly enables the user to maintain control over price, timeliness of performance and completion of the job.

In view of the foregoing explanations and demonstrations of the patentable distinctions between the prior art and Applicant's pending claims, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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